



TFW 3623

PATENT
Customer No. 22,852
Attorney Docket No. 07781.0013-00000
SAP Reference No. 2000P0001 US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Stefan HACK et al.) Group Art Unit: 3623
)
Application No.: 09/609,714) Examiner: Jonathan G. Sterrett
)
Filed: June 30, 2000)
)
For: VALUE CHAIN OPTIMIZATION) Confirmation No.: 2503
SYSTEM AND METHOD)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated April 7, 2006, the Examiner required restriction under 35 U.S.C. § 121 between Group I - Claims 1-5, 6-20, 26-54, and 58-65; Group II - Claims 21-23, 55-57, and 66; and Group III - Claims 24-25. Applicants provisionally elect, with traverse, Group I - claims 1-5, 6-20, 26-54, and 58-65.

Applicants traverse the restriction requirement on the basis that the Examiner has failed to establish that restriction is proper.

First, the Examiner has not established that there would be a serious burden in examining all of the claims at once. *Applied Materials Inc. v. Advanced Semiconductor Materials*, 40 U.S.P.Q.2d 1481, 1492 (Fed. Cir. 1996). In fact, "[i]f the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct

inventions." M.P.E.P. § 803 (emphasis added). Applicants submit that there is no additional burden to examining all of the claims at once especially in view of the multiple Office Actions that have been issued in the past and that have examined all the pending claims on the merits. In fact, Applicants respectfully note that the Patent Office has issued seven Office Actions examining either all or some of the pending claims and Applicants' representatives have conducted multiple interviews and have filed multiple Requests for Continued Examinations ("RCEs").

Second, the Examiner concludes that the inventions claimed by each group are "related as subcombinations disclosed as usable together in a single combination," but argues that they are distinct because they are all "separately usable," citing to MPEP § 806.05(d). According to § 806.05(d), the Examiner "must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." In the Office action, however, the Examiner does nothing more than repeat the preamble of one of the claims and characterize it as having "separate utility."

For at least these reasons, Applicants respectfully traverse and request reconsideration and withdrawal of the restriction requirement.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 5, 2006

By: 

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